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TO: EXAMINER Longbit Chai
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SERIAL NO. 09/990,216

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Enclosed: Appeal Brief + Cover

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Edward W. Goodman

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

Atty. Docket

ELMO M.A. DIEDERIKS ET AL.

PHNL 000637

Serial No.: 09/990,216

Group Art Unit: 2131

Filed: November 21, 2001

Examiner: L. Chai

Title: DEVICE FOR STORING AND REPRODUCING AUDIO AND/OR VIDEO


Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed is an original copy of an Appeal Brief in the
above-identified patent application.

Please charge the fee of \$500.00 to Deposit Account
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Respectfully submitted,

By 
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DEVICE FOR STORING AND REPRODUCING AUDIO AND/OR VIDEO

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P.O. Box 1450
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Sir:

APPEAL BRIEF

This is an appeal from the Examiner of Group 2131 finally rejecting claims 1, 2 and 4-7 in this application.

(i) Real Party in Interest

The real party in interest in this application is KONINKLIJKE PHILIPS ELECTRONICS N.V. by virtue of an assignment from the inventors recorded on February 7, 2002, at Reel 12586, Frames 0393-0394.

(ii) Related Appeals and Interferences

There are no other appeals and/or interferences related to this application.

PHNL000637-BRIEF-010306

1

(iii) Status of the Claims

Claims 1, 2 and 4-7 stand finally rejected by the Examiner, claim 3 having been cancelled.

(iv) Status of Amendments

There was one Response filed on September 12, 2005, after final rejection of the claims on August 4, 2005, this Response having been considered by the Examiner.

(v) Summary Of Claimed Subject Matter

The subject invention related to a device for storing and reproducing audio and/or video data, the device including a semiconductor memory for storing the data in digital form. One of the problems of such devices is that the user can access the audio and or video data in digital form, which lends to the possibilities of illegally copying and distributing the stored data.

As shown in Fig. 3, and described in the specification on page 5, line 16 to page 6, line 8, a storage medium 1" includes a semiconductor memory 3 for storing audio and/or video data in digital form, and a conversion unit 4/5 for converting the stored digital data into analog useful signals. These analog useful signals are now externally available from the storage medium 1" and may be applied to a reproduction device 2" including an amplifier 6 and a loudspeaker 7. As indicated by arrows in Fig. 3, the output

from the semiconductor memory 3 is only applied to the decoder 4, while the output from the decoder 4 is only applied to the converter 5. "As a result, only analog signals are now externally available from the medium 1", which provides complete protection against making digital copies."

(vi) Grounds of Rejection to be Reviewed on Appeal

- (A) Whether the invention, as claimed in claims 1, 2 and 5, is anticipated, under 35 U.S.C. 102(b), by U.S. Patent 4,677,657 to Nagata et al.
- (B) Whether the invention, as claimed in claim 4, is unpatentable, under 35 U.S.C. 103(a), over Negata et al. in view of U.S. Patent 5,734,726 to Truchsess.
- (C) Whether the invention, as claimed in claim 6, is unpatentable, under 35 U.S.C. 103(a), over Negata et al. in view of U.S. Patent 4,905,289 to Micic et al.
- (D) Whether the invention, as claimed in claim 7, is unpatentable, under 35 U.S.C. 103(a), over Negata et al. in view of U.S. Patent 6,122,230 to Scibora.

(vii) Arguments

- (A) The Nagata et al. patent discloses a voice recording card for recording and reproducing a message. In a recording mode, the message is applied through a microphone, converted into a digital

signal and recorded in a memory. The voice card comprises a D/A converter for converting the digital data stored in the memory to analog data, which can be reproduced as a voice from the speaker. In particular, "The digital data stored in the memory 22 can be transmitted through the transmitting and receiving apparatus 3" (see col. 4, lines 49-51). In contrast with the storage medium of the subject invention, the output lines of the apparatus described in Nagata et al. are not exclusively connected to an output of the conversion unit. Rather, the digital audio data, stored in the memory, can be easily accessed for copying.

As claimed in claim 1, "the output lines of the storage medium, on which the useful analog audio and/or video output signals are made available to the reproducing apparatus, are connected to the conversion unit, for making only the analog audio and/or video output signals externally available from the storage medium, while the audio and/or video data is not externally available in digital form".

It is well founded that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Appellants therefore submit that the above element of claim 1 is neither shown nor suggested by Nagata et al.

In response thereto, the Examiner states, in paraphrasing the language in claim 1, "...and in that the output lines of the storage medium, on which the analog audio and/or video output signals are made available to the reproducing apparatus, are connected to the conversion unit (Nagata: see for example, Column 4, Line 42-45)), for making only the analog audio and/or video output signals externally available from the storage medium (Nagata: see for example, Column 4 Line 44-45), while the audio and/or output is not externally available in digital form (Nagata: see for example, Column 4 Line 41-42): the digital data is stored internally in the memory)."

The portion of Nagata et al. cited by the Examiner (i.e., col. 4, lines 40-45) reads as follows:

"The A-D converter 21 converts analog data such as a message entered through the microphone 14 to digital data, which is stored in the memory 22. The D-A converter 23 converts the digital data stored in the memory 22 to analog data, which can be reproduced as a voice from the speaker 15."

This portion of Nagata et al. states that the output from the memory 22 in the voice recording card 1 is connected to the converter 23 which supplies analog signals to a speaker 15 incorporated as part of the voice recording card 1. Hence, the output lines of the voice recording card 1 (the storage medium as claimed in claim 1) are not connected to the output of the conversion unit as specifically claimed in claim 1. Rather,

Appellants submit that the Examiner does not address the portion of Nagata et al. that specifically states:

"Since the memory 22 is connected to the interface 24 and the interface 24 is connected to the transmitting and receiving apparatus 3 via the contact 18, the digital data stored in the memory 22 can be transmitted through the transmitting and receiving apparatus 3...." (col. 4, lines 47-51).

As such, contrary to the limitation in claim 1 which states "the output lines of the storage medium, on which the useful analog audio and/or video output signals are made available to the reproducing apparatus, are connected to the conversion unit, for making only the analog audio and/or video output signals externally available from the storage medium, while the audio and/or video data is not externally available in digital form", the output lines of Nagata et al., i.e., contact 18 (shown in Fig. 2), are not connected to the conversion unit, but rather are connected through the interface 24 directly to the memory 22, thereby providing the stored digital signals to the outside of the voice recording card, directly opposite from that which is claimed in claim 1.

(B) The above arguments regarding Nagata et al. are incorporated herein.

The Truchsess patent discloses a device and method for controlling digitally-stored sounds to provide smooth acceleration and deceleration effects, in which a voice IC 30 contains integrated memory and a digital-to-analog converter 24.

The Examiner now states "It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Truchsess within the system of Nagata, because Truchsess teaches providing a more compact and highly integrated system wherein the memory and converter are all incorporated in a voice IC (Truchsess: see for example, figure 5 & Column 5 Line 34-37)."

Appellants would like to note that in *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), the court indicated that if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

Appellants submit that Truchsess teaches away from that disclosed in Nagata et al., i.e., the ability to access the digital data stored in the memory. Hence, the combination of Truchsess with Nagata et al. would render at least a portion of Nagata et al. inoperative. Further, there then would not be any connections for the output 18 of Nagata et al.

It is important to note that Truchsess relates to "A device and method for producing sound which simulates the sound of an engine, whereby sound segments are digitally stored in memory and accessed by a microcontroller which is responsive to a user accessible switch." (see Abstract). As such, there is no need or

desire for the user to directly access the data stored in the memory.

However, even though Truchsess incorporates the memory and the converter in a voice IC, there is no disclosure that the voice IC does not have pins assigned to the output of the memory portion of the voice IC thereby enabling the output 18 of Nagata et al.

As such, Appellants submit that Truchsess does not supply that which is missing from Nagata et al., i.e., "the output lines of the storage medium, on which the useful analog audio and/or video output signals are made available to the reproducing apparatus, are connected to the conversion unit, for making only the analog audio and/or video output signals externally available from the storage medium, while the audio and/or video data is not externally available in digital form."

(C) The above arguments regarding Nagata et al. are incorporated herein.

The Micic et al. patent discloses an apparatus for the digital storage of audio signals employing read only memories, in which, as noted by the Examiner, the semiconductor memory is a read-only memory.

However, Appellants submit that Micic et al. does not supply that which is missing from Nagata et al., i.e., "the output lines of the storage medium, on which the useful analog audio and/or

video output signals are made available to the reproducing apparatus, are connected to the conversion unit, for making only the analog audio and/or video output signals externally available from the storage medium, while the audio and/or video data is not externally available in digital form."

(D) The above arguments regarding Nagata et al. are incorporated herein.

Scibora patent discloses a universal compressed audio player in which "The universal compressed audio player further comprises a programmable digital signal processor (DSP) 114. DSPs are readily available from a large number of sources, one example being the Butterfly DSP from SHARP Microelectronics..."

The Examiner appears to believe that this DSP discloses the claim 7 limitation "the conversion unit is configurable subject to authorization and/or irreversibly."

Appellants believe that the Examiner is incorrectly interpreting claim 7. In particular, in the specification on page 4, lines 17-26, it is specifically stated:

"Moreover, the conversion unit of the device can be configured in predetermined types, configuration being effected only subject to authorization control and/or in irreversible form. This means that configuration of the conversion unit requires the possession of a given access key (authorization control) and/or that once configuration has taken place it cannot be cancelled. As a result of such a configurability of the conversion unit it possible that a customer can purchase the device in technically different and differently priced


configurations, the relevant configuration being determined by an authorized seller upon the purchase. Configuration can be effected, for example, in that certain parts of the circuits in the conversion unit are disabled so as to tailor it to the customer's ideas about features and quality."

Appellants submit that Scibora neither discloses or suggests configuring the DSP in such a manner.

Further, Appellants submit that Scibora does not supply that which is missing from Nagata et al., i.e., "the output lines of the storage medium, on which the useful analog audio and/or video output signals are made available to the reproducing apparatus, are connected to the conversion unit, for making only the analog audio and/or video output signals externally available from the storage medium, while the audio and/or video data is not externally available in digital form."

Based on the above arguments, Appellants believe that the subject invention is neither anticipated nor rendered obvious by the prior art and is patentable thereover. Therefore, Appellants respectfully request that this Board reverse the decisions of the Examiner and allow this application to pass on to issue.

Respectfully submitted,

by 
Edward W. Goodman, Reg. 28,613
Attorney

(viii) Appendix

CLAIMS ON APPEAL

1. (Previously Presented) A storage medium for storing audio and/or video data, the storage medium including a semiconductor memory for storing the audio and/or video data in digital form, characterized in that the storage medium includes a conversion unit for converting the digital audio and/or video data into analog audio and/or video output signals suitable for reproduction by a reproducing apparatuses, and in that the output lines of the storage medium, on which the analog audio and/or video output signals are made available to the reproducing apparatus, are connected to the conversion unit, for making only the analog audio and/or video output signals externally available from the storage medium; while the audio and/or video data is not externally available in digital form.

2. (Previously Presented) The storage medium as claimed in claim 1, characterized in that the conversion unit includes a decoder for decoding compressed and/or encoded data.

3. (Cancelled).

4. (Previously Presented) The storage medium as claimed in claim 1, characterized in that the semiconductor memory and the conversion unit are integrated in a single microchip.

5. (Previously Presented) The storage medium as claimed in claim 4, characterized in that the storage medium takes the form of a chip card.

6. (Previously Presented) The storage medium as claimed in claim 1, characterized in that the semiconductor memory is a read-only memory.

7. (Previously Presented) The storage medium as claimed in claim 1, characterized in that the conversion unit is configurable subject to authorization control and/or irreversibly.

(ix) Evidence Appendix

There is no evidence which had been submitted under 37 C.F.R. 1.130, 1.131 or 1.132, or any other evidence entered by the Examiner and relied upon by Appellant in this Appeal.

(x) Related Proceedings Appendix

Since there were no proceedings identified in section (ii) herein, there are no decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c) (1) (ii) of 37 C.F.R. 41.37.